

## **REMARKS**

In the Office Action mailed December 20, 2005, claims 1-51, 53, 54, 56-61 and 63-65 were pending and stood rejected. With this response, Applicants have amended claims 1, 17, 24, 37, 40, 42 and 59. No new matter is introduced into the application by the claim amendments. Re-examination of the application is requested.

### **Statement of status and support for all claim amendments**

Claim 1 is amended to state that the step of acting on the support with aqueous covered dampening rollers is performed in situ on a printing press. Support for this claim is found at Col. 2, lines 56-62.

Claim 17 is amended to replace the term "the ink-train" with "an ink-train" in order to properly introduce the term "ink-train" to the claims.

Claim 24 is amended to replace the term "radiation absorbing dye" with "infrared-absorbing dye." The term radiation absorbing dye had no antecedent basis.

Claim 37 is amended to state that the polymerizable radiation-sensitive composition includes an infrared-absorbing material rather than a radiation-absorbing material. Support for this amendment is found at Col. 2, lines 23-29. Claim 37 is also amended to state that the step of acting on the coating is performed "in situ" on a printing press. Support for this amendment is found at Co. 1, lines 57-59.

Claims 40 and 42 depend from claim 37 and are amended to be consistent with claim 37. In both claims 40 and 42, the term "radiation-absorbing material" is replaced with "infrared-absorbing material." Support for these amendments is found at Col. 2, lines 23-29.

Claim 59 is amended to state that the coating of the radiation-sensitive composition is applied to a lithographic support having a hydrophilic surface at a predetermined thickness. Support for this claim is found in claim 25 and at Col. 3, lines 10-24.

### **Specification**

The Examiner states that the copy of the specification filed by the Applicants is improper because it does not incorporate changes made by the Certificate of Correction dated May 21, 2002. The Examiner states that the “changes must be entered in the reissue application by incorporating them as part of the original patent and not as changes to the reissue.”

With this response, the Applicants submit a clean copy of the specification, a Petition under 37 C.F.R. § 1.183 to waive rules 37 C.F.R. § 1.125(d) and 37 C.F.R. § 1.173(a)(1) as directed by MPEP 1411.1, and the required fee. The Applicants therefore request that the Examiner enter the submitted clean copy of the specification in this reissue application.

### **Oath or Declaration**

The Examiner states that the reissue oath or declaration filed with this application is defective because the Applicants submitted a Supplemental Second Preliminary Amendment on March 25, 2005 which is not addressed in the executed reissue declaration. The Examiner rejected all pending claims as being based upon a defective reissue oath or declaration under 35 U.S.C. § 251.

With this response, the Applicants submit a Supplemental Declaration for Reissue Patent Application to Correct “Errors” Statement. The Applicants therefore respectfully request that this rejection be withdrawn.

### **Claim Rejections – 35 U.S.C. § 112**

The Examiner states that all pending claims are rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Specifically, the Examiner states that the original patent is drawn to a method of preparing a printing form using “digitally controlled” laser output while claims 1 and 25 recite “laser means” and claims 37 and 59 recite “an infrared laser” in the present application.

The Applicants respectfully submit that Examples 1-13 of the original patent provide support for the use of non-digitally controlled laser means and an infrared laser in the method of the present invention. In the method described in Examples 1-13, a coated substrate was cut into a circle and placed on a disc that

could be rotated between 100-2500 revolutions per minute. The specification then states that “adjacent to the spinning disc a translating table held the source of the laser beam so that the laser beam impinged normal to the coated substrate, while the translating table moved the laser beam radially in a linear fashion with respect to the spinning disc.” See Col. 3, lines 28-35. Examples 1-13 do not describe only digitally controlling the laser. Instead, a translating table moves the laser beam. The Applicants respectfully submit that the laser beam is not digitally controlled in the method described in Examples 1-13 and therefore provides support for the method of the pending claims. For at least this reason, the Applicants respectfully request that this rejection be withdrawn.

#### **Claim Rejections – 35 U.S.C. § 251**

The Examiner rejected all pending claims under 35 U.S.C. § 251 as based upon new matter added to the patent. Specifically, the Examiner states that “since the original patent is drawn to a method of preparing a printing form using a *digitally controlled* laser output, present limitations ‘laser means’ and ‘infrared laser’ (without the phrase ‘digitally controlled’) constitute new matter.” See pages 3-4 of the Office Action. As stated above, the Applicants respectfully submit that the laser beam control is not limited to only digitally controlled in the method described in Examples 1-13 and therefore provides support for the method of the pending claims.

The Examiner also states that claims 37-51, 53, 54, 56-61 and 63-65 are rejected as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Specifically, the Examiner states that claim 37 “omits the claim limitation as to the radiation-sensitive compound comprising a phthalocyanine pigment...and additionally comprising an infrared absorbing dye was presented in the amendment of March 2, 2000 to obviate a rejection (see also the amendment of October 2, 2000).” The Examiner also states that claim 59 “omits the claim limitation, ‘a desired run length for the printing is predetermined and the thickness of the ink coated is determined according to the desired run length.’”

The Applicants respectfully submit that claims 37-51, 53, 54, 56-58 do not improperly recapture surrendered subject matter. Recapture of surrendered subject

matter is found by applying a three-part test. In re Clement, 131 F3d 1464 (Fed. Cir. 1998). The first step is to determine whether and in what aspect the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspects of the reissued claim relate to surrendered subject matter. In order to surrender subject matter claimed in the original patent application, the subject matter must have been relied upon in the original application to make the claims allowable over the art. See MPEP 1412.02. Reliance can be by way of presentation of a new or amended claim or an argument or statement by the applicant that a limitation of the claim defines over the art. However, a general statement regarding the patentability the claims as a whole which is not specific as to the limitation relied upon, will not, by itself, be sufficient to establish surrender and recapture. The third step is to determine whether the reissue claims were materially narrowed in other respects to avoid the recapture rule.

The Applicants concede that reissue claim 37 is not limited to a method in which the infrared-absorbing compound is a phthalocyanine pigment and is therefore broader than claim 1 of the issued patent in this respect. However, the Applicants submit that this broader aspect of the reissue claim is not related to any surrendered subject matter. The amendment of March 2, 2000 in the original patent application does not present a new claim or amended claim related to the phthalocyanine pigment. Independent claim 1 was present in the original application as claim 16 which depended on claims 1, 12, and 13. Therefore, claim 16 cannot be considered a "new" claim. Furthermore, claim 16 cannot be considered "amended" in the March 2, 2000 response to overcome any cited references because it did not incorporate a new feature or limitation. Instead, the Applicants merely re-wrote claim 16 in independent form at the request of the Examiner. As originally filed, Claim 16 contained all of the limitations included in claims 1, 12, and 13 by virtue of its dependency on claims 1, 12, and 13. By re-writing claim 16 in independent format in the March 2, 2000 response, the Applicants did not surrender any subject matter in this claim.

In the amendment of October 2, 2000, the Applicants did amend claim 16, but only to provide antecedent basis for the term "radiation absorbing compound." This amendment was not done to define the claim over any cited reference and therefore cannot be considered as surrendering subject matter.

Second, there was no argument or statement by the Applicants that the limitations that were present in claim 16 made it allowable over the prior art. Instead, the Applicants merely stated that claim 16 was rewritten in independent form because the Examiner indicated that claim 16 was allowable but objected to as being dependent on a rejected base claim. The Applicants did say that claim 16 was in condition for immediate allowance, but this is merely a general statement addressing the allowability of the claim and is not specific as to the limitation being relied upon. MPEP 1412.02 states that such boiler plate language will not, by itself, be sufficient to establish surrender and recapture of subject matter.

Third, the Applicants never took the position later in the prosecution that the phthalocyanine limitation distinguished claim 16 over the art cited by the Examiner. In the Office Action mailed May 3, 2000, the Examiner reversed her position and stated that claim 16 written in independent form was rejected under 35 U.S.C. 103 as being unpatentable over D'Heureuse (GB 22284684) in view of Fan et al (5,654,125) and Fan et al (5,262,275). In response, the Applicants successfully argued that there was no motivation to combine these three references. These references were the same references that the Examiner used to originally reject claim 1. The Applicants did not argue that the phthalocyanine limitation overcame the rejection. Instead, they argued that there was no motivation to combine these references. Since the Applicants did not take the position the phthalocyanine limitation made claim 16 allowable over the cited art, there was no surrender of this subject matter.

The Applicants have amended claim 59 to state that the step of applying a coating includes applying the radiation-sensitive composition at a thickness determined according to a desired run length.

For at least these reasons, the Applicants respectfully request that this rejection be withdrawn.

#### **Claim Rejections – 35 U.S.C. § 103**

The Examiner rejected claims 1-4, 7-12, 14-16 and 24 under 35 U.S.C. § 103 as being unpatentable over Yamaoka et al. (5,756,258) in view of Sulzberg (4,173,554) and Sorresso (3,919,754). As stated above, claim 1 has been amended

to state that the step of acting on the support with aqueous covered dampening rollers is performed in situ on a printing press.

The Applicants submit that the combination of Yamaoka et al., Sulzberg and Sorresso does not teach or suggest the subject matter of claim 1 as now amended. Specifically, the cited references do not teach or suggest a method in which the step of removing the unexposed ink coating is performed on a printing press.

Yamaoka et al. reports a photopolymerizable composition that includes an addition-polymerizable compound which has at least one ethylenically unsaturated double bond with a radical-producing agent, a squarylium compound, and, if necessary, a binder polymer, a thermal polymerization inhibitor, a colorant comprising an organic or inorganic dyeing pigment, a plasticizer, or a sensitivity-improving agent. See Col. 7, lines 5-15 of Yamaoka et al.. Yamaoka et al. also reports a method of forming a printing plate with the photopolymerizable composition by coating the composition onto a base to form a photosensitive sample, subjecting the photosensitive sample to irradiation of light, and removing the unexposed portions of the photosensitive sample with a developer. See Col. 14, lines 28-33 of Yamaoka et al.. While Sorresso does report the use of dampening rollers to carry dampening solutions to printing plates, neither Sorresso or Sulzberg report or suggest the method of claim 1 in which the development step is performed on a printing press. The Applicants therefore respectfully submit that claim 1 as amended is not rendered obvious by Yamaoka et al. in view of Sulzberg and Sorresso for at least this reason.

Since claims 2-4, 7-12, 14-16 and 24 ultimately depend on claim 1, the Applicants reiterate their argument with respect to Yamaoka et al., Sulzberg and Sorresso. The Applicants submit that these claims are also not rendered obvious by Yamaoka et al. in view of Sulzberg and Sorresso for at least the same reason as claim 1 and respectfully request this rejection be withdrawn.

The Examiner rejected claims 5 under 35 U.S.C. § 103 as being unpatentable over Yamaoka et al. (5,756,258) in view of Sulzberg (4,173,554) and Sorresso (3,919,754) as applied to claim 1 and further in view of Reichel (5,492,059). Since claim 5 depends on claim 1, the Applicants reiterate their arguments with respect to claim 1. Furthermore, Reichel does not teach or suggest

the subject matter of claim 1 in which the developing step is performed in situ on a printing press. Reichel reports an offset printing form that includes at least one printing plate that is in the form of a sleeve. The Applicants submit that neither Yamaoka et al., Sulzberg, Sorresso or Reichel, alone or in combination, teach or suggest the subject matter of claim 5 and respectfully request that this rejection be withdrawn.

The Examiner rejected claims 17-19 under 35 U.S.C. § 103 as being unpatentable over Yamaoka et al. (5,756,258) in view of Sulzberg (4,173,554) and Sorresso (3,919,754) as applied to claim 1 and further in view of Mattor (3,847,614). Since claims 17-19 ultimately depend on claim 1, the Applicants reiterate their arguments with respect to claim 1. Furthermore, Mattor does not teach or suggest the subject matter of claim 1 in which the developing step is performed in situ on a printing press. Instead Mattor describes lithographic printing plates having a photopolymer composition. The Applicants submit that neither Yamaoka et al., Sulzberg, Sorresso or Mattor, alone or in combination, disclose or suggest the subject matter of claims 17-19 and respectfully request that this rejection be withdrawn.

The Examiner rejected claims 37-41, 44, 45, 47, 50, 57-59 and 63 under 35 U.S.C. § 103 as being unpatentable over Yamaoka et al. (5,756,258) in view of Bi (5,599,650). Specifically, the Examiner states that "Yamaoka et al. does not explicitly state that his development step is done on-press. However, on-press development is well known in the art...as evidenced by Bi et al." See Office Action, page 10. The Applicants respectfully submit that there is no motivation to combine the method of imaging a printing plate with infrared radiation described in Yamaoka et al. with the step of on-press development described in Bi.

As noted by the Examiner, Yamaoka et al. describes photopolymerizable compositions that are highly sensitive to visible and near infrared light. See Col. 1, lines 17-21 of Yamaoka et al.. These compositions may be used to form printing plates by coating a photopolymerizable composition on a base, subjecting the coating to near infrared irradiation with a near infrared laser, and removing the unexposed portion of the coating with a developer. See Col. 14, lines 18-50 of Yamaoka et al.. The development step is not described as being on-press.

In contrast, Bi describes a lithographic printing plate that is imaged through exposure to ultraviolet radiation. See Col. 20, lines 15-17, lines 56-58 and Col. 22, lines 39-41 of Bi. The plates may then be developed on-press. See Col. 17, lines 5-10 of Bi. Bi does not suggest that the step of on-press development may be done after imaging with infrared radiation. The compositions and processes for infrared imaging is different than the compositions and processes for UV imaging.

Since Yamaoka et al. does not suggest the step of on-press development and Bi does not suggest that the step of on-press development may be performed on plate that is sensitive to or imaged with infrared radiation, the Applicants respectfully submit that there is no motivation in either Yamaoka et al. or Bi to include the on-press development step of Bi in the method of imaging a printing plate with infrared radiation described in Yamaoka et al.. Therefore, the Applicants respectfully request that this rejection be withdrawn.

The Examiner rejected claims 42, 43, and 46 under 35 U.S.C. § 103 as being unpatentable over Yamaoka et al. (5,756,258) in view of Bi (5,599,650) as applied to claim 37 and further in view of Sulzberg (4,173,554). Since claims 42, 43, and 46 ultimately depend on claim 37, the Applicants reiterate the arguments made above with respect to Yamaoka et al. and Bi. Sulzberg describes various aqueous printing inks. Sulzberg does not teach or suggest a method of imaging a printing plate with infrared radiation followed by on-press development. Therefore, the Applicants respectfully request that this rejection be withdrawn.

The Examiner rejected claim 51 under 35 U.S.C. § 103 as being unpatentable over Yamaoka et al. (5,756,258) in view of Bi (5,599,650) as applied to claim 37 and further in view of Mattor (3,847,614). Since claim 51 depends on claim 37, the Applicants reiterate the arguments made above with respect to Yamaoka et al. and Bi. As noted above, Mattor describes lithographic printing plates having a photopolymer composition. Mattor does not teach or suggest a method of imaging the lithographic printing plates with infrared radiation followed by on-press development. The Applicants respectfully request that this rejection be withdrawn.

The Examiner rejected claim 56 under 35 U.S.C. § 103 as being unpatentable over Yamaoka et al. (5,756,258) in view of Bi (5,599,650) as



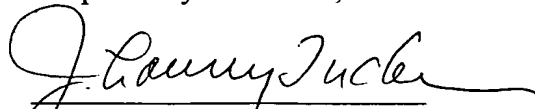
applied to claim 37 and further in view of Sorresso (3,919,754). Since claim 56 depends on claim 37, the Applicants reiterate the arguments made above with respect to Yamaoka et al. and Bi. Sorresso is directed toward a dampening roller which may be used to carry water or other solutions to printing plates. Sorresso does not teach or suggest a method of imaging a printing plate in which the development step is performed on-press. The Applicants respectfully request that this rejection be withdrawn.

The Examiner rejected claim 65 under 35 U.S.C. § 103 as being unpatentable over Yamaoka et al. (5,756,258) in view of Bi (5,599,650) as applied to claim 37 and further in view of Tanikawa et al. (5,674,664). Since claim 65 ultimately depends on claim 37, the Applicants reiterate the arguments made above with respect to Yamaoka et al. and Bi. Tanikawa et al. is directed to a method of and apparatus for recycling paper. Specifically, it is directed to a method of and apparatus for regenerating copying or printing paper from paper bearing an image formed of thermofusible or heat-softening ink. Tanikawa et al. does not state that the image-bearing support may be a lithographic support. Furthermore, Tanikawa et al. does not teach or suggest a method of imaging a printing plate with infrared radiation followed by on-press development. The Applicants respectfully request that these rejections be withdrawn.

### Conclusion

Applicants submit that all of the pending claims as amended are now in condition for allowance. A notice to that effect is respectfully solicited.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

## **APPENDIX A – Marked-up Version Showing Claim Amendments**

1. (Twice Amended) A method for preparing a printing form, the method comprising:
  - coating a layer of a radiation sensitive ink on a lithographic support having a hydrophilic surface layer to form an ink coating,
  - imaging the ink coating by laser means to form exposed areas and unexposed areas of the ink coating, and
  - acting on the support with aqueous covered dampening rollers in situ on a printing press to remove the unexposed areas of the ink coating thereby revealing the hydrophilic surface of the support and leaving an oleophilic image formed from the exposed areas of the ink coating,in which:
  - the laser means emits in the visible or infra-red region of the spectrum;
  - the ink comprises a radiation absorbing compound;
  - the radiation absorbing compound is a phthalocyanine pigment; and
  - the ink additionally comprises an infra-red absorbing dye.
17. (Amended) The method of claim 1 or claim 3 in which means are present in [the] an ink-train to coat a predetermined thickness of ink onto the hydrophilic surface.
24. (Amended) The method of claim 1 in which the [radiation] infrared-absorbing dye is selected from the group consisting of dyes of the squarylium, cyanine, merocyanine, indolizine, pyrylium, and metal dithiolene classes.
37. (Twice Amended) A method for preparing a printing form, the method comprising:
  - a) providing a polymerizable radiation-sensitive composition comprising a resin and [a radiation]an infrared-absorbing material;
  - b) applying a coating of the radiation-sensitive composition to a lithographic support having a hydrophilic surface;
  - c) imagewise exposing the coating to infrared radiation using an infrared laser to produce exposed areas and unexposed areas of the coating; and
  - d) on a printing press in situ, acting on the coating to remove the unexposed areas of the coating, thereby revealing the hydrophilic surface of the support and leaving an oleophilic image formed from the exposed areas of the coating.

40. (Amended) The method of claim 37, wherein the [radiation] infrared-absorbing material is an infrared-absorbing dye.

42. (Amended) The method of claim 37, wherein the [radiation] infrared-absorbing material is an infrared-absorbing pigment.

59. (Twice Amended) A method for printing, comprising:

a) providing a polymerizable radiation-sensitive composition comprising a resin and a radiation-absorbing material;

b) applying a coating of the radiation-sensitive composition to a lithographic support having a hydrophilic surface at a predetermined thickness;

c) imagewise exposing the coating to infrared radiation using an infrared laser to produce exposed areas and unexposed areas of the coating; and

d) on a printing press, acting on the coating to remove the unexposed areas of the coating, thereby revealing the hydrophilic surface of the support and leaving an oleophilic image formed from the exposed areas of the coating.

e) contacting the oleophilic image with a printing ink; and

f) imagewise transferring the printing ink from the oleophilic image to a printing substrate.